

REMARKS

This Amendment is in response to the Office Action mailed August 5, 2005. Claims 1 and 11 have been added. Claims 24-31 have been added. Reconsideration of the allowability of the pending claims is respectfully requested.

Provisional Double Patenting Rejection

In the Office Action, claims 1, 3-4, 9 and 11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting, citing U.S. Patent Application No. 09/822,986. Applicants tentatively agree to file a terminal disclaimer once the claims are in condition for allowance. The Examiner is encouraged to contact the undersigned attorney once the claims are in condition for allowance so that a proper terminal disclaimer may be filed.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-4, 6-7, 9-13 and 15-20 were rejected under 35 U.S.C. as being unpatentable over Spear (USP 6,611,925) in view of Garrison (EP 2069745 A1) and Walsh (USP 5,956,481). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all of the claim limitations.

With respect to independent claim 1, Applicant respectfully submits that neither Spear, Garrison nor Walsh, alone or in any combination, describe or suggest a signature generator that is coupled to the file analyzer to *receive both the scanning result and the scanned file and to produce a digital signature of the digital signature chain based on the scanning result and the*

scanned file.... Emphasis added. In the Office Action, it is alleged that Walsh discloses “the scanning result and the scanned file are outputted to accompany a digital signature chain.” *See column 15, lines 58-62 of Walsh; see Page 5 of the Office Action.* Applicants respectfully point out that this interpretation of claim 1 is inconsistent with our claimed invention, which is directed to the scanning result and the scanned file being used to produce a digital signature of the digital signature chain that accompanies the scanned file. *See Figure 7 of the subject application.* Applicants respectfully request the Examiner to reconsider the allowability of claims 1, newly added claim 24 and those claims dependent thereon.

In addition, claim 11 has been amended to include the limitation that the digital signature chain includes a digital signature produced by the signatory and is based on the file and a scanning result of the file. The scanning result is used to indicate if the file has an acceptable file integrity. Reconsideration of claim 11 as well as those claims dependent thereon is respectfully requested.

Of course, if any further discussion is needed to facilitate prosecution of the subject application, the Examiner is invited to contact the undersigned attorney to further discuss the allowability of the pending claims if the Examiner still considers the claims are not in condition for allowance. The undersigned attorney can be reached at the telephone number listed below.

Appl. No. 09/823,131
Amdt. Dated 10/11/2005
Reply to the Office Action of August 5, 2005

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: October 11, 2005

By


William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

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Date: 10/11/2005


Susan McFarlane

10/11/2005

Date